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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,641	11/28/2001	Vincent Mutel	20772	5346

151 7590 03/21/2003

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
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EXAMINER

SAEED, KAMAL A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 03/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,641

Applicant(s)

MUTEL ET AL.

Examiner

Kamal A Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 12 and 21-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 10, 11 and 13-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

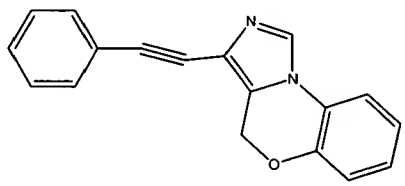
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DETAILED ACTION

Claims 1-31 are pending in this application. Claims 1-9, 12 and 21-31 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

Response to Restriction

In response to the restriction requirement, applicants' representative, Patricia S. Rocha-Tramaloni, in Paper No. 6, filed on March 4, 2003, has elected with traverse the invention of Group I, claims 10, 11, and 13-20, drawn to compounds and pharmaceutical composition of



compounds of Formula I-A, and the species of

3-Phenylethynyl-4H-5-oxa-2,9b-diaza-cyclopenta[a]naphthalene, described in Example 25, page 35 of the specification is acknowledged. The traversal is on the ground(s) that the examine each of the elected species could be extended to other group without imposing an undue burden on the Examiner. This is not found persuasive because each of the various species are directed to art recognized compounds which are different from each other in structure and element and, are capable of supporting their own patents. Additionally, the fields of search are not co-extensive as they fall into multiple classes and subclasses (class 544, 546, 548 and several subclasses) and the examiner is required to conduct a commercial data base search on the class and each subclass. This would be an undue burden on the examiner.

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Therefore, the restriction requirement deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

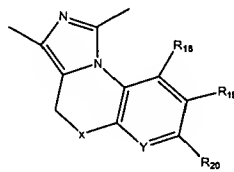
Applicants preserve their right to file a divisional on the non-elected subject matter.

Status of the Claims

Claims 1-31 are pending in this application. Claims 1-9, 12 and 21-31 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

The generic concept of the elected subject matter is as follows:

Compound of the Formula I-A, depicted in claim 13, wherein $R^1 - R^5$ are independently selected from the group consisting of H, lower alkyl, $-(CH_2)_n$ -halogen, lower alkoxy, $-(CH_2)_n$ -NRR', $-(CH_2)_n$ -N(R)-C(O)-lower alkyl or aryl; R and R' are independently selected from the



group consisting of H, and lower alkyl; B is B4 i.e., $R^{18} - R^{20}$ are independently selected from the group consisting of H, lower alkyl, $-(CH_2)_n$ -halogen or lower alkoxy; X, is O or S; Y is CH= and N=.

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As a result of the election and the corresponding generic concept identified supra, the remaining subject matter of claims 10, 11, and 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 1-24 (in part), 13 and 14 are properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct therefrom, i.e., a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Objections

Claims 10, 11, and 13-20 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. Claims drawn to methods of use of compounds of formula I-A, would be allowable along with the elected invention and commensurate in scope therewith.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right)

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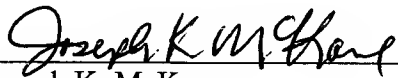
“Official” for papers that are to be entered into the file, and “ Unofficial” for draft documents and other communications with the PTO that are not for entry into the file of the application.

This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D.
March 20, 2003



Joseph K. McKane
Supervisory Patent Examiner
AU 1626
Technology Centre 1